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ELMORE PATENT LAW GROUP, PC
515 GROTON ROAD
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OFFICE OF PETITIONS

In re Application of :
Miao et al. :
Application No. 10/774,047 : ON APPLICATION FOR
Filed: February 6, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 4056.1066 US1 :

This is in response to the REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b) filed on November 13, 2008. Applicants request that the determination of patent term adjustment be increased from seven hundred thirteen (713) days to at least one thousand three hundred forty-nine (1349) days. Applicants request this correction in part on the basis that the Office will take in excess of three years to issue this patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 1.702(a)(4) or applicant delay under 1.704(c)(10) until the actual date of issuance of the patent has been determined. As

such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued. Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. As such, it is appropriate to dismiss as premature such a request.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is dismissed.

On October 14, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 713 days. The instant application for patent term adjustment was timely filed. Applicants assert that an adjustment of 100 additional days for Office delay is warranted because the restriction requirement mailed April 16, 2007 was vacated, and a complete Office action was not mailed until January 22, 2008, four (4) months and 100 days after applicants filed a reply to the initial restriction requirement on June 14, 2007.

Applicants' contention has been considered, but not found persuasive. Pursuant to 37 CFR 1.703(a)(1):

The period of adjustment under § 1.702(a) is the sum of the following periods: the number of days, if any, in the period beginning on the day after the date

that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

On June 14, 2007, an election and amendment was filed in response to the restriction requirement mailed on April 16, 2007. In response, on July 24, 2007, a non-final Office action was mailed, within four (4) months of the filing of applicant's reply on June 14, 2007. On January 8, 2008, an Interview Summary was mailed, stating that the restriction requirement will be rewritten and that applicants found an additional reference. Also on January 8, 2008, a new restriction requirement was mailed. On January 22, 2008, an Examiner-Initiated Interview Summary was mailed, along with a supplemental restriction requirement. On February 1, 2008, a reply to the restriction requirement was mailed. On March 20, 2008, a non-final Office action was mailed.

Applicants' arguments and evidence have been considered, in light of the application history, and it has been determined that the initial period of adjustment pursuant to § 1.702(a)(2) is correct.

Pursuant to 35 U.S.C. 154(b)(1)(A)(i)(ii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the failure of the Office to respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken. In this regard, the Office did respond within four (4) months to petitioner's election filed on June 14, 2007, by issuing the Office action mailed on July 24, 2007. The Office action mailed on July 24, 2007 was not vacated. That another Office action was mailed on January 8, 2008, and a supplemental Office action was mailed on January 22, 2008, does not alter the fact that the Office did respond to the reply within 4 months after the date on which the reply was filed.

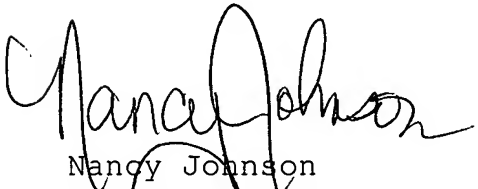
Accordingly, the period of adjustment was properly calculated as 713 days, counting the number of days beginning on April 6, 2005, the day after the date that is fourteen months after the date on which the application was filed, to April 16, 2007, the

date of mailing of the restriction requirement, minus twenty-seven (27) days for applicant delay in filing a response on December 9, 2004, three (3) months and twenty-seven (27) days after mailing of the notice to file missing parts mailed on August 12, 2004. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is seven hundred thirteen (713) days.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" being more prominent than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions